

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

REMARKS

Claims 1-12 are pending in this application. No amendment has been made in this Response. It is believed that this Response is fully responsive to the Office Action dated **May 23, 2005**.

Claim 10 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with applicant regards as the invention. (Office Action page 2, first paragraph no. 2)

The rejection of claim 10 is respectfully traversed.

Claim 10 recites a method for printing the printed matter of claim 2, and depends ultimately from claim 1. The Examiner states that claim 1 recites that the fixed information is on the receiving layer and the receiving layer is on the paper, and that this is inconsistent with claim 10.

However, Applicant notes that claim 1 recites: “said surface of the printing paper having a printing ink film containing fixed information”; thus the **“fixed information” is on the surface of the printing paper**. The “surface” refers to the immediate surface of the paper, before any additional layers. Claim 1 also recites: “a printed matter having a receiving layer for an ink jet recording ink for printing variable information formed on the entire or a part of the surface of a printing paper.” Therefore, the **“variable information” is on a receiving layer**, which is on the surface of the printing paper. However, claim 1 does **not** recite that the “fixed information” is on the receiving layer. Claim 1 therefore requires the structural order: paper/fixed

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

information/receiving layer/variable information. The fixed information is either underneath or side-by-side with the receiving layer.

Claim 10 recites that the fixed information is printed first, and then the receiving layer, which would yield the structural order: paper/fixed information/receiving layer. This is consistent with claim 1.

Reconsideration of the rejection is therefore respectfully requested.

Claims 1-6, 10, and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al. (Office Action pages 2-4, paragraph nos. 2-4)

The rejection of claims 1-6, 10 and 12 is respectfully traversed.

The Examiner cites Phillips for teaching a greeting card, and takes paper 12 as corresponding to the printing paper of claim 1. The Examiner also refers to the disclosure of ink jet printing on the paper, in column 1, lines 45-46, as corresponding to the variable information of claim 1.

The Examiner notes that Phillips does not teach a receiving layer comprising an ink-absorbing and ink-fixing resin. In fact, Applicant notes, Phillips does not explicitly mention any receiving layer. Phillips does disclose that the paper sheet 12 can be “ink jet” (column 2, line 29), which might inherently have a receiving layer. However, the disclosure of Phillips in column 2, lines 26-29, is apparently of paper stock, which would not have any fixed information as it is produced.

In Phillips, the paper is preprinted lithographically (column 3, lines 17-21). However,

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
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Phillips does not give any specific details of how this would be done if “ink jet” paper were used, but seems to imply that the lithographic printing would be **on top** of whichever of the listed papers was used. By contrast, claim 1 requires that the printing ink film containing fixed information be **on the surface of the printing paper, that is, side-by side with or underneath the receiving layer.** Phillips gives no disclosure of or suggestion for this claimed structure.

The Examiner specifically cites Otani for the disclosure of two receiving layers, as in claim 2. Otani discloses an ink jet recording paper having at least one side of a base paper coated with at least two ink-receiving layers. However, this appears to be a disclosure of a blank ink jet paper, and there appears to be **no suggestion for fixed information under the ink-receiving layers.**

Applicant therefore submits that the only way to combine Otani with Phillips would be to use Otani’s ink jet recording paper as the “ink jet” paper as the paper stock in Phillips (column 1, line 29). Again, Phillips’ disclosure of lithographic printing appears to be on top of any paper stock used, which would not result in the structure of claim 1, and would be **inconsistent** with the method of claim 10.

That is, the combination of Phillips and Otani suggested by the Examiner would yield a greeting card (printed matter) comprising: a paper sheet having a receiving layer on the entire surface thereof; and a printing ink film containing fixed information provided on the receiving layer by lithography printing, wherein variable information is printed on the receiving layer by an ink jet recording method.

However, there has been known no ink jet-receiving layer wherein a satisfactory ink jet ink

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

image (variable information) can be printed by an ink jet recording method as well as a satisfactory printing ink image (fixed information) can be printed by lithography printing (see the specification, page 2, lines 21 to 25). When a printing ink is printed on a conventional ink jet-receiving layer by lithography printing, it is impossible to form a satisfactory printing ink image such as letter, character or picture due to repelling of the printing ink by the receiving layer. This is known to persons skilled in the art.

The printed matter of the present invention has a structure wherein the receiving layer and the printing ink film are present on printing paper in a side-by-side relationship, or a structure wherein the receiving layer is present on the printing ink film formed on printing paper. These structures enable the formation of a satisfactory receiving layer on the printing paper or the printing ink film. For example, when a coating liquid for an ink jet-receiving layer is applied onto the printing ink film, the repelling of the coating liquid by the printing ink film does not interfere with the formation of a satisfactory ink jet-receiving layer on the printing ink film.

In the present invention, the lamination order of the printing ink film and the ink jet-receiving layer is clearly recited in the claims. The combination of Phillips and Otani does not teach or suggest the presently claimed lamination order.

Reconsideration of the rejection is therefore respectfully requested.

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Philips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,708,612 to Schmid. (Office Action page 4)

The rejection of claims 10 and 12 is respectfully requested.

Schmid is cited for the teaching of anilox rollers. However, as noted above, the combination of Phillips with Otani et al. does not provide a suggestion for “printing fixed information **and then forming the receiving layer**”. In particular, the combination of Phillips and Otani would use Otani’s ink jet paper, which presumably would be blank ink jet paper in which the ink-receiving layers are applied to the base paper with no fixed information underneath. The disclosure of Schmid does not overcome this failing of the combination of Phillips and Otani with regard to claim 10, or with regard to claim 1, from which claim 10 ultimately depends.

Reconsideration of the rejection is therefore respectfully requested.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,830,329 to Iwata. (Office Action page 5)

The rejection of claims 10 and 12 is respectfully requested.

Iwata is cited for the use of a steel and rubber roll, which the Examiner takes as equivalent to an anilox roll. However, as noted above, the combination of Phillips with Otani et al. does not provide a suggestion for “printing fixed information **and then forming the receiving layer**”. As

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

discussed above, the combination of Phillips and Otani would use Otani's ink jet paper, which presumably would be blank ink jet paper in which the ink-receiving layers are applied to the base paper with no fixed information underneath. The disclosure of Iwata does not overcome this failing of the combination of Phillips and Otani with regard to claim 10, or with regard to claim 1, from which claim 10 ultimately depends.

Reconsideration of the rejection is therefore respectfully requested.

Claims 7-8 and 11 are objected to as being dependent upon a rejected base claim.

(Office Action page 5)

Reconsideration of the objection is respectfully requested. As Applicant has argued that the base claims are not obvious over the combination of Phillips and Otani et al., Applicant has not amended the present claims.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

U.S. Patent Application Serial No. 10/030,099
Amendment filed August 22, 2005
Reply to OA dated May 23, 2005

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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